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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,014	07/25/2003	John Bruce Clayfield Davies	7194-4	3991

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WOODARD, EMHARDT, MORIARTY, MCNETT & HENRY LLP
111 MONUMENT CIRCLE, SUITE 3700
INDIANAPOLIS, IN 46204-5137

EXAMINER

HOFFMAN, MARY C

ART UNIT	PAPER NUMBER
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3733

MAIL DATE	DELIVERY MODE
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07/18/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

5

Office Action Summary	Application No. 10/628,014	Applicant(s) DAVIES, JOHN BRUCE CLAYFIELD	
	Examiner Mary Hoffman	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 20-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19, 27 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>07/25/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I, claims 1-19 and 27-28 in the reply filed on 04/26/2007 is acknowledged. The traversal is on the ground(s) that there is no undue burden and that claim 27 should be included in Group I. The examiner agrees that claim 27 should be included in Group I, since claim 27 appear to be dependent from claim 1 (see "Claim Objections" section below regarding claim 27). However, the examiner does not agree that there is no undue burden to search for both the two groups, because "a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation of separate classification" (see M.P.E.P. § 808.02). In the instant case, the inventions have separate classifications.

Claims 20-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 04/26/2007.

The requirement is still deemed proper and is therefore made FINAL.

Specification

The abstract of the disclosure is objected to because it includes phrases that can be implied, i.e. "this invention relates to". Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

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The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Objections

Claims 1-19 and 27-28 are objected to because of the following informalities:

In claim 1, line two, Applicant recites "a least one portion" which should be changed to "at least one expansion portion" to be clearer for examination purposes and be consistent with the rest of the claim (see claim 1, line 3, where the same limitation is recited as the "at least one expansion portion")

In claim 10, line two, Applicant recites "a least one portion" which should be changed to "at least one expansion portion" to be clearer for examination purposes and be consistent with the rest of the claim.

In claim 11, line two, Applicant recites "a least one portion" which should be changed to "at least one expansion portion" to be clearer for examination purposes and be consistent with the rest of the claim.

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In claim 15, line two, Applicant recites "a least one portion" which should be changed to "at least one expansion portion" to be clearer for examination purposes and be consistent with the rest of the claim.

In claim 17, line 1, Applicant recites "the/each" which appears to be a typo.

In claim 18, line 2, Applicant recites "the/each" which appears to be a typo.

In claim 27, line 1, Applicant recites "according to any claim 1", which should be corrected, e.g. change to --according to claim 1--. Also, the term "expansion module" in line 2 lacks antecedent basis.

In claim 28, line two, Applicant recites "a least one portion" which should be changed to "at least one expansion portion" to be clearer for examination purposes and be consistent with the rest of the claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-13, 15-19 and 27-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Naybour (U.S. Patent No. 6,200,349).

Naybour discloses a bone portion securing device adapted to be received within a bone cavity, the device including at least one expansion portion (ref. #4) capable of

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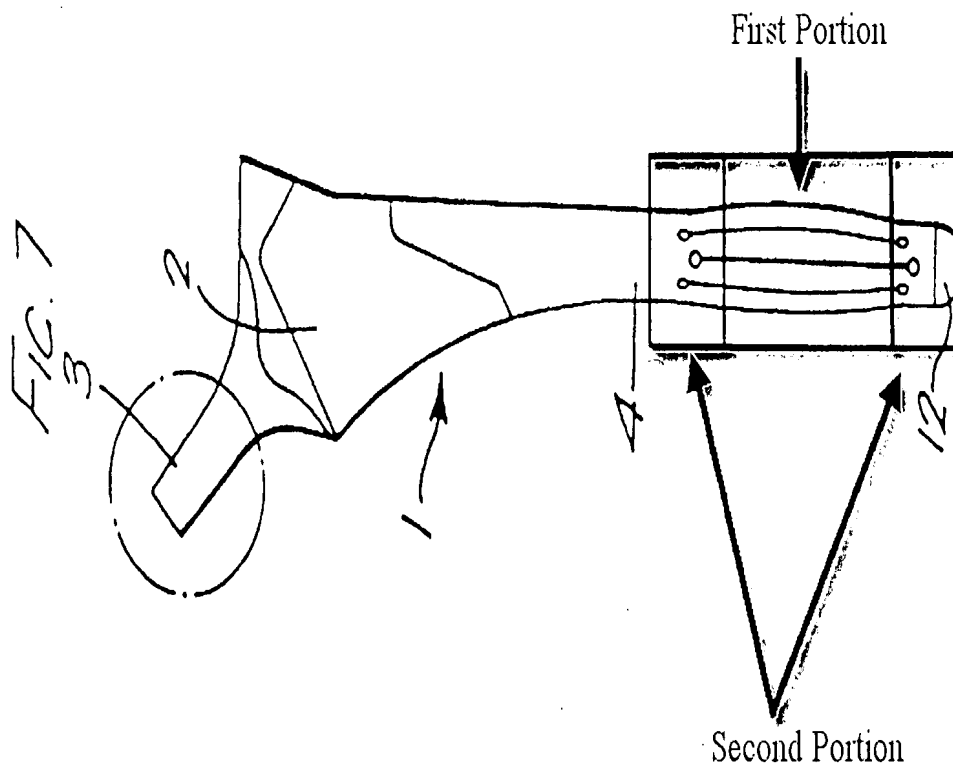
being radially expanded under an applied force, the at least one expansion portion having at least one portion (mid-portion of ref. #4, see marked-up figure below), at least one characteristic of which is selected to be different to a corresponding at least one characteristic of at least one other portion (portions surrounding mid-portion, see marked-up figure below) of the expansion portion.

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The at least one characteristic comprises a thickness and/or width of the at least one portion and the at least one other portion. The expansion portion comprises at least one elongate portion having a pair of elongate slots (ref. #6) on either side thereof. The at least one portion comprises a first end of the at least one elongate portion and a second

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end of at least one elongate portion. The at least one other portion comprises a mid portion of the elongate portion forming a remainder of the elongate portion. The first end and/or second end of the elongate portion is thinner or thicker and/or narrower or broader than an adjacent portion of the at least one elongate portion (see ref. #12). The at least one portion further comprises a first end of at least one slot and a second end of at least one slot. The at least one other portion comprises a mid portion of the slot forming a remainder of the slot. The first end and/or the second end of at least one slot is broader than an adjacent portion of the at least one slot (see ref. #11). The device including at least one portion capable of being radially expanded under an applied force, wherein the at least one expansion portion is shaped to elastically bow outwards when a compressive force is applied axially to the expansion portion. The device including at least one portion capable of being radially expanded under an applied force, wherein the at least one expansion portion comprises at least one longitudinal portion fixed at either end to means which engage a compression coupling, wherein a profile of the at least one longitudinal portion is narrowed at one or both ends of the at least one longitudinal portion. A plurality of longitudinal portions substantially equidistant spaced around a circumference of the expansion module are provided. The longitudinal portion has a curved profile. The device including at least one portion capable of being radially expanded under an applied force, wherein the at least one expansion portion includes at least one slot, the slot having at least one portion having a width greater than a width of a remainder of the at least one slot. At least one portion and the remainder of the slot are longitudinally displaced. The expansion portion includes a plurality of elongate slots.

Each slot includes first and second wider portions at first and second ends of the slot. The remainder of the slot is substantially of a uniform width. The expansion module is made of titanium or titanium alloy (see claim 13). An expansion module for use as a portion of a bone portion securing device adapted to be received within a bone cavity, the module including at least one portion capable of being radially expanded under an applied force, the at least one expansion portion having at least one portion, at least one characteristic of which is selected to be different to a corresponding at least one characteristic of at least one other portion of the expansion portion.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Naybour (U.S. Patent No. 6,200,349) in view of Gianezio et al. (U.S. Patent No. 4,520,511).

Naybour discloses the claimed invention except for serrations.

Gianezio et al. disclose serrations to increase gripping effect (col. 2, lines 10-13).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to construct the device of Naybour with serrations in view of Gianezio to increase gripping effect.

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Conclusion

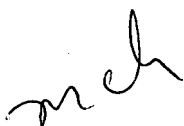
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Hoffman whose telephone number is 571-272-5566. The examiner can normally be reached on Monday-Friday 9:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MCH



EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER